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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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5514	7590	04/06/2004	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			HAQ, NAEEM U	
			ART UNIT:	PAPER NUMBER
			3625	

DATE MAILED: 04/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/386,330

Applicant(s)

OKADA ET AL

Examiner

Naeem Haq

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114

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-15 and 17-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-15 and 17-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Response to Amendment

This action is in response to the Applicants' amendment D, paper number 16, filed on January 8, 2004. Claims 1-5, 7-15, and 17-23 are pending and will be considered for examination.

Final Rejection

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 10 and 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. These claims recite the limitation of "...executing appearance of an approval processing window in response to selection of the selection approval button, and of executing appearance of a rejection processing window in response to selection of the selection reject button..." In addition, the claims also recite a purchase approving step and a purchase rejection step. The specification and amendment D teach that the appearance of the approval window is an event that is

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mutually exclusive of the appearance of the rejection window. Likewise the specification and amendment teach that the approval step is mutually exclusive of the rejection step. However, the claim language recites that both the approval window and step occur at the same time as the rejection window and step. There is no written support for this in the Applicants' specification. For examination purposes, the Examiner will assume that the approval window and step are an alternative to the rejection window and step (i.e. either one event occurs or the other, but not both).

Claims 10 and 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. These claims recite the limitation of "...executing appearance of an approval processing window in response to selection of the selection approval button, and of executing appearance of a rejection processing window in response to selection of the selection reject button..." In addition, the claims also recite a purchase approving step and a purchase rejection step. The specification and amendment D teach that the appearance of the approval window is an event that is mutually exclusive of the appearance of the rejection window. Likewise the specification and amendment teach that the approval step is mutually exclusive of the rejection step. However, the claim language recites that both the approval window and step occur at the same time as the rejection window and step. For examination purposes, the Examiner will assume that

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the approval window and step are an alternative to the rejection window and step (i.e. either one event occurs or the other, but not both).

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 7, 10, 17, 20, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoquist et al. (US Patent 5,361,199) in view of Sudman et al. (US Patent 5,385,475).

Referring to claims 1, 10, and 17, Shoquist discloses a purchase request approving apparatus capable of approving a purchase request of a desired article (column 1, line 64 – column 2, line 25), comprising: display means for displaying a list window, wherein the list window contains a list of articles for which approval is requested (Figures 4 and 14); selecting means for selecting an article, in accordance with a user operation, from the articles displayed in the list window (column 5, lines 16-22). Shoquist does not disclose that the display means includes a selection approval button to display an approval processing window, and a selection reject button to display a rejection processing window, or executing appearance of an approval processing window in response to selection of the approval button and executing appearance of a rejection window in response to selection of the rejection button. However, Shoquist teaches that his display means includes menu selections for approval and rejection actions (Figure 12B and 18A). Moreover Shoquist teaches that

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in the preferred embodiment, the user interface is designed to display multiple display windows in response to selection of an action from the menu (column 4, lines 62-68; Figure 15). Therefore, at the time the invention was made, it would have been obvious to one of ordinary skill in the art to replace a menu selection with a button selection. Applicants have not disclosed that a button selection mechanism provides an advantage over a menu selection mechanism, or that such a button selection mechanism is used for a particular purpose or solves a stated problem which is not solved by the menu selection mechanism. Furthermore, one of ordinary skill in the art would have expected Applicants' invention to perform equally well with a menu selection mechanism because it allows a buyer to approve or reject an article from a list window. Therefore, it would have been obvious to one of ordinary skill in this art to modify the selection mechanism of Shoquist to obtain the invention as specified in the claim. Furthermore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to display separate windows in response to the approval or rejection menu selections. One of ordinary skill in the art would have been motivated to do so in order to provide a user with a confirmation window so that the user could verify the action to be taken. Shoquist does not teach that the approval processing window has an approval button to perform an approval process and approval cancel button to cancel approval processing, or that the rejection window has a reject button to perform a rejection process and a reject cancel button to cancel the rejection process. However, Sudman teaches a confirmation window that has a button to perform an action and a button to cancel an action (Figure 19, item "158"). Therefore it would have been

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obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the confirmation window of Sudman into the apparatus of Shoquist. One of ordinary skill in the art would have been motivated to do so in order to provide a user with a way to verify his or her action, as taught by Sudman (column 22, lines 27-35). Furthermore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have separate confirmation windows for the approval and rejection processes because Shoquist teaches that in the preferred embodiment, the user interface is designed to display multiple display windows in response to selection of an action from the menu (column 4, lines 62-68). One of ordinary skill in the art would have been motivated to do so in order to provide a user with a way to verify the action to be taken. Shoquist also teaches a purchase approving means for storing the selected article as an approved article in the database, and deleting the selected article from the list in the list window in response to selecting the approval process (column 7, lines 24-29). Shoquist does not explicitly teach a purchase rejection means for storing the selected article as a rejected article in the database in response to selecting the reject button in the rejection processing window. However, Shoquist teaches that a buyer may return a purchase order to the requisitioner (Figure 18A). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to store the rejected article in a database in response to a rejection process. One of ordinary skill in the art would have been motivated to do so in order to allow the buyer or requisitioner to retrieve the rejected purchase order at a later date.

Referring to claim 7, Shoquist teaches request means for (i) inputting information associated with the desired article to be purchase-requested (Figures 6, 7, 8B, and 13) and (ii) information for requesting approval of purchase of the desired article and storing the input information in the database (column 3, lines 17 – column 5, lines 28).

Referring to claim 20 and 23, Shoquist teaches a selection means/step from a list window. Shoquist and Sudman do not explicitly disclose that the list window has a select box corresponding to each listed article, and said selecting means/step selects an article, in accordance with a user operation, by selecting the select box corresponding to the article. However, at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add a select box to the apparatus and method of Shoquist and Sudman. Applicant has not disclosed that selection box provides an advantage, is used for a particular purpose or solves a stated problem. Furthermore, one of ordinary skill in the art would have expected Applicants' invention to perform equally well with selection means and step of Shoquist because Shoquist's selection mechanism allows a user to uniquely identify a particular item from the list window. Therefore, it would have been obvious to one of ordinary skill in this art to modify Shoquist to obtain the invention as specified in the claims.

Claims 2, 3, 11, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoquist et al. (US Patent 5,361,199) in view of Sudman et al. (US Patent 5,385,475) and further in view of Langhans et al (US Patent 5,500,513). Shoquist and Sudman lack a group identifier. However, Langhans teaches the use of a division identifier. It would have been obvious to one of ordinary skill in the art at the

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time of the invention to provide Shoquist and Sudman with a division identifier as taught by Langhans in order to facilitate the approval process. It behooves the approver to know what the requester does in order to determine if the request pertains to the work of the requester.

Claims 2-5, 8, 9, and 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoquist et al. (US Patent 5,361,199) in view of Sudman et al. (US Patent 5,385,475) and further in view of Barnes et al (US Patent 5,970,475).

Barnes discloses purchasing control system comprising:

- a hierarchical structure identifier;
- means to adjust the hierarchy;
- department adjuster;
- level of "authorization defining pre-selected goods/services that the user has available for viewing from said supplied catalog";
- users having access to different areas depending on the tasks they perform;
- purchase approving means notifying a user that a purchase price exceeds a predetermined limit;
- display means is a browser of an Internet connected to a communication network;
- wherein the client terminal is connected to a network that can use an intranet environment.

Shoquist and Sudman lack the explicit disclosure of:

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- the ranking of employees, and
- the determining the catalog based on the ranking.

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide Shoquist and Sudman with the means to rank employees as taught by Barnes in order to determine which employees were able to aid the approver in approving the request. It would also have been obvious to one of ordinary skill in the art at the time of the invention to provide Shoquist and Sudman with limiting the catalog for certain users as taught by Barnes in order to save time by limiting what a user could see in the vendor's catalog. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide Shoquist and Sudman with a means of notifying a user that a spending limit had been exceeded in order to ensure that a user did not exceed his or her limit. Finally, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide Shoquist and Sudman with an Internet browser connected to a communication network capable of an Intranet environment in order to control IT costs and to use a commercially well-known, user-friendly software interface.

Claims 18, 19, 21, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoquist et al. (US Patent 5,361,199) in view of Sudman et al. (US Patent 5,385,475) and further in view of Catalog Age "Insight aims for 1-to-1 via e-mail".

Referring to claims 18, 19, 21, and 22, Shoquist and Sudman do not teach means for or step for sending and receiving e-mail from a requestor having a URL to display the list window or status of a selected article. Catalog Age teaches means for

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and step for sending and receiving e-mail with a URL to display product information.

Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Catalog Age into the cited prior art.

One of ordinary skill in the art would have been motivated to do so in order to reduce costs. Catalog Age does not teach that the URL displays a list window. However, the Examiner notes that this limitation is not functionally involved in the elements of the recited system. Therefore this limitation is deemed to be nonfunctional descriptive material. The steps and elements for sending and receiving e-mail would be the same regardless of what the URL displayed. The difference between the prior art and the Applicants' list window is merely subjective. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the URL display a list window in the system and method of Catalog Age because such display does not functionally relate to the elements or steps of the claimed system and method and because the subjective interpretation of a display does not patentably distinguish the claimed invention.

Response to Arguments

Applicant's arguments with respect to claims 1, 10 and 17 have been considered but are moot in view of the new ground(s) of rejection.

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Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (703)-305-3930. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff A. Smith can be reached on (703)-308-3588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

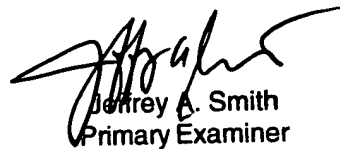
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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Naeem Haq, Patent Examiner
Art Unit 3625

April 5, 2004



Jeffrey A. Smith
Primary Examiner